



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/821,009

03/29/2001

R. Alan Whitehurst

8516

7590

06/02/2004

DANIEL P. MCCARTHY  
PARSONS BEHLE & LATIMER  
201 SO. MAIN STREET, SUITE 1800  
SALT LAKE CITY, UT 84111

EXAMINER

SAADAT, CAMERON

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

CS

**Office Action Summary****Application No.**

09/821,009

**Applicant(s)**

WHITEHURST ET AL.

**Examiner**

Cameron Saadat

**Art Unit**

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3713

### DETAILED ACTION

In response to amendment filed 2/23/2004, claims 1-56 are pending in this application.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-22, 24-44, and 46-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Siefert (USPN 6,386,883 B2).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended.

Response to the applicant's remarks are provided below and incorporated herein.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

Art Unit: 3713

3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 23 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert (USPN 6,386,883 B2).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended.

Response to the applicant's remarks are provided below and incorporated herein.

***Response to Arguments***

Applicant's arguments filed 2/23/2004 have been fully considered but they are not persuasive.

Applicant asserts that Siefert does not disclose the step of "assessing the students understanding of the information in each of said strategies", but instead assesses whether the resources are successfully imparting the knowledge desired to the students. Applicant argues that a resource is distinct from a strategy. However, Siefert discloses "multiple resources which represent the multiple strategies" (Col. 9, lines 7-8). Thus, Siefert clearly discloses the step of assessing the students understanding of the information in each of a plurality teaching strategies, since each resource employs a different strategy.

Applicant additionally emphasizes that Seifert makes no disclosure of "*ranking* each of the instructional strategies based on the success of the student's comprehension evaluation". According to the Merriam-Webster dictionary, the definition of a *rank* is: to determine the relative position of; to take precedence of; to take or have a position in relation to others. Siefert discloses a teaching and evaluation method wherein different teaching strategies are selected over one another based on an evaluation of a student's success on a previous lesson (Col. 9, lines

Art Unit: 3713

52-56; Col. 12, lines 28-35). Therefore, a preferred strategy is selected based upon a student's evaluation, wherein the preferred strategy takes precedence over other strategies that are not selected, rendering the preferred strategy with a higher position than the strategies that are not selected.

Applicant similarly purports that Siefert does not disclose the step of "optimizing the presentation of information by increasing the use of those instructional strategies having a higher ranking than the other instructional strategies" However, Siefert clearly discloses these features (Col. 9, lines 52-56; Col. 12, lines 28-35).

It is asserted, by the applicant, that the examiner has made no attempt to identify the limitations of "a presentation engine", "a data store", "an assessment engine", a "learning management system", "data entry means", "a display means", and "a content development tool", and these limitations are therefore not disclosed in Siefert. However, it is noted by the examiner, that these limitations of the system claim have substantially similar subject matter as the method claims, wherein the examiner has identified all of the claimed limitations in Siefert. It is the examiner's position that these limitations consist of hardware and software components of a computer system for carrying out the specific method claims. For example, the function of the "a presentation engine" as claimed, is to present information to a student using a plurality of instructional strategies. Siefert not only discloses a method comprising the specifically claimed step of presenting information, but also indicates implementing this method step utilizing hardware and software components of a personal computer (column 9, lines 5-10; See Fig. 1). Siefert additionally discloses a data store and a data entry means (Col. 5, lines 4-11); an

Art Unit: 3713

assessment engine (See Fig. 2); a learning management system (See Fig. 1); a content development tool (Col. 5, lines 4-11); and a display (Col. 15, line 15).

Again, applicant asserts, that the examiner has made no attempt to identify the limitations of “defining a course to be presented”, “preparing a plurality of concepts from the course” and “characterizing each concept in at least one of a plurality of instructional strategies, wherein the course presentation can select among the instructional strategies to present to a student based on those strategies that provide the student with the best comprehension over the other strategies”. Siefert discloses all of these limitations (Col. 9, lines 5-10, lines 52-56; Col. 12, lines 28-35).

Therefore, the rejection of claims 1, 14, 20, 26, 36, 46, and 52, under 35 U.S.C. 102(e) is maintained.

Applicant emphasizes that Siefert does not disclose summaries of concepts. However, the examiner maintains that Siefert discloses the feature of providing a summary of each concept (column 16, lines 47-50).

Applicant emphasizes that Siefert does not disclose the step of “establishing pre-requisites needed by the student to enable the student to view the information. However, column 8, lines 7-18 in Siefert clearly discloses this step.

Applicant alleges that Siefert does not disclose the generation evaluation instruments. However, Siefert does disclose the generation of evaluation instruments (See Fig. 2; Col. 12, lines 28-35).

Applicant asserts that Siefert does not disclose the limitation of performing the information assessment step prior, during, and after the information presentation step as described in claim 7. It is noted that applicant’s amended claim does not include this limitation.

Art Unit: 3713

Applicant emphasizes that Siefert does not disclose instructional strategies that are selected from the group comprising problem solving, simulation, and analogy. However, column 16, lines 16-19 clearly discloses an instructional strategy using analogy.

Applicant purports that Siefert does not disclose the feature of tracking the frequency of use of each instructional strategy. However, in column 16, lines 16-21, Siefert discloses that “to help Johnny solve this challenge, two guides provide assistance: one explains things using analogies and associations, and the other uses logical, linear, no-frills explanations. Johnny is frequently asked which of these guides he wants to ask for advice; in this way, the system can determine whether Johnny has a preferred learning style”. Therefore, it is evident that each guide provides a different instructional strategy, and the system tracks how often the student resorts to one instructional strategy or another, in order to determine which instructional strategy is favored. Thus, Siefert discloses all of the claimed subject matter.

Applicant alleges that Siefert does not teach the feature of selecting an instructional approach for use under a selected instructional strategy, arguing that “a preferred learning style” is not an instructional strategy or an instructional approach. However, Applicant has failed to recognize that once a student selects a “preferred learning style”, the system described in Siefert selects an instructional approach within said preferred learning style (column 16, lines 16-19). Therefore, Siefert discloses all of the claimed subject matter.

Applicant further asserts that Siefert does not disclose the feature of assigning a task to an author to develop content for the information to be presented. Applicant argues that the custodian described in Siefert (column 6, lines 26-39) is not disclosed to make assignments. It is noted that the claim language does not require that the author be able to make assignments.

Art Unit: 3713

Instead applicant claims that a task is assigned to the author, and this feature is disclosed in Siefert.

Applicant purports that Siefert does not disclose the feature of “repeating each step of assessing different strategies for new information”. However, Seifert discloses this feature in Col. 16, lines 16-21.

Applicant emphasizes that Siefert does not disclose the feature of building profiles of learning styles based on the performance of instructional strategies, arguing that the profile described in Siefert (Col. 7, lines 55-59) is based on a student’s preference made prior to the learning process, and is not based on the performance of instructional strategies. Applicant’s interpretation of the Siefert reference is misleading and inaccurate. Siefert clearly builds student profiles including student learning styles, which are based on the student’s performance of instructional strategies (Col. 10, lines 37-47).

It is asserted by the applicant that Siefert does not disclose the feature of providing assignment to students to be performed outside of a learning session. However, Siefert discloses that, after the diagnostic step, a student is provided with the option of “further study”, wherein the further study option will provide customized remedial content to the student, including explanations, examples, and practice situations (Col. 15, lines 11-43).

Applicant further emphasizes that Siefert provides no suggestion to present instructional strategies in random order. Applicant concedes that Siefert does not teach a predetermined order of presenting each instructional strategy. Therefore, the orderless presentation of instructional strategies described in Siefert, if not inherently random, would suggest to one of ordinary skill in the art to provide no predetermined order thus rendering the order random.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

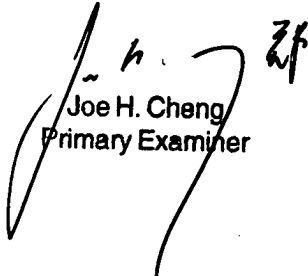
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CS

  
Joe H. Cheng  
Primary Examiner